

SECTION III—REMARKS

This amendment is submitted in response to the final Office Action mailed August 9, 2005, for the above-noted patent application. No claims are amended herein, and claims 1-29 remain pending in the application. Applicants respectfully request reconsideration of the application and allowance of all pending claims in view of the following remarks.

Declaration Under 37 C.F.R. § 1.132

Pursuant to 37 C.F.R. § 1.132, Applicants have submitted herewith the declaration of Mr. Bruce R. Scharf. The declaration explains the methodology and presents the results of tests conducted by the assignee. The tests were conducted on a Metanetics Corporation scanner believed to be the same scanner shown and described in U.S. Patent No. 6,019,286 to Li *et al.* (“Li”), or at least believed to have the same optical arrangement as the scanner shown in Li. The declaration includes several color photographs as exhibits. Applicants believe that the color photographs are necessary to adequately illustrate the tests conducted. Nonetheless, Applicants have enclosed herewith a copy of the declaration with black-and-white photographs.

As set forth in the declaration, the tests conclusively show, contrary to the Examiner’s assertion, that the targeting beams used in Li do not intersect at the center of the field of view of the imaging optics regardless of the distance between the target and the imaging optics of the scanner.

The declaration was not previously submitted because the Examiner had not, until the final office action, considered and refuted Applicants’ arguments regarding the disclosure of U.S. Patent No. 6,019,286 to Li *et al.* (“Li”). Specifically, prior to the final office action the Examiner had not yet considered and refuted Applicants’ arguments based on the teachings of Figures 7 and 9 of Li, which suggest that the vertical and horizontal targeting beams used in Li do not remain at the center of the field of view of the imaging optics regardless of the distance between the target and the imaging optics of the scanner. Applicants respectfully request entry and consideration of the enclosed declaration.

Rejections Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1-3, 6, 7, 10 and 13 as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 6,019,286 to Li *et al.* (“Li”). Applicants respectfully traverse the Examiner’s rejections. A claim is anticipated only if each and every

element, as set forth in the claim, is found in a single prior-art reference. MPEP § 2131; *Verdegaal Bros. v. Union Oil of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). As explained below, Li cannot anticipate these claims because it does not disclose every element and limitation recited therein.

Claim 1 recites an apparatus combination including a base capable of receiving a camera including a lens and a projector coupled to the base and adapted to project a plurality of beams of light onto a plane positioned at a focus distance from the base, wherein the projections of the beams of light on the plane are geometric shapes, and wherein an intersection of the geometric shapes is “at the center of the field of view of the lens independent of the distance between the lens and the plane” when the lens is installed on the base.

Li does not disclose a combination including the recited limitations. As is clearly and convincingly shown in the enclosed declaration, the intersection of the targeting beams of Li changes position as the distance between the target and the imaging optics is changed. The test results in the declaration are consistent with Figures 7 and 9 of Li and accompanying text. As shown in Figure 9, the first targeting optic 72 includes an aspherical entry surface 76 and a horizontally-oriented cylindrical exit surface 78. The exit surface 78 is tipped at an angle “a” from the center (col. 10, line 16); this tipping shifts the horizontal position of the horizontal bar (Fig. 7) such that it is *horizontally* centered in the target area (col. 10, lines 22-23). Li says nothing about *vertical* centering of the horizontal bar. Similarly, in the second targeting optic 74 the vertically-oriented cylindrical surface 86 is tipped at an angle “b” relative to the center, but there is no disclosure, teaching or suggestion in Li that this tipping of the second targeting optic results in the vertical bar being either horizontally or vertically centered in the field of view. Li therefore cannot disclose, teach or suggest an apparatus combination in which an intersection of the geometric shapes is “at the center of the field of view of the lens independent of the distance between the lens and the plane.” Applicants submit that the claim is therefore allowable, and respectfully request withdrawal of the rejection.

As to claims 2-3, 6 and 7, if an independent claim is allowable, then any claim depending therefrom is also allowable. *See, e.g.*, MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 1 is in condition for allowance. Applicants submit that claims 2-3, 6 and 7 are therefore allowable by virtue of their dependence on an allowable independent

claim, as well as by virtue of the features recited in the claims. Applicants respectfully request withdrawal of the rejections and allowance of these claims.

Claim 10 recites a method combination including projecting a first light beam onto a plane, wherein the projection of the first light beam on the plane is a first geometric shape; projecting a second light beam onto the plane, wherein the projection of the second light beam on the plane is a second geometric shape; and aligning the first and second beams such that an intersection of the first and second geometric shapes is at the center of the field of view of a lens of a camera “independently of the distance between the lens and the plane.” By analogy to the discussion above for claim 1, Li does not disclose, teach or suggest a combination including these limitations. Applicants submit that the claim is therefore allowable, and respectfully request withdrawal of the rejection.

As to claim 13, if an independent claim is allowable then any claim depending therefrom is also allowable. *See, e.g.*, MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 10 is in condition for allowance. Applicants submit that claim 13 is therefore allowable by virtue of its dependence on an allowable independent claim, as well as by virtue of the features recited in the claim. Applicants respectfully request withdrawal of the rejection and allowance of this claim.

Rejections Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 4-5, 8-9, 11-12 and 14-29 under 35 U.S.C § 103(a) as obvious in view of, and therefore unpatentable over, various combinations of the following references: Li, U.S. Patent No. 5,598,007 to Bunce *et al.* (“Bunce”) and European Patent No. EP1128315 to Rigoni *et al.* (“Rigoni”).

As to claims 4-5, 8-9, 11-12 and 14, Applicants respectfully traverse the Examiner’s rejections. If an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claims 1 and 10 are neither anticipated nor obvious, and are therefore in condition for allowance. Applicant respectfully submits that claims 4-5, 8-9, 11-12 and 14 are therefore allowable by virtue of their dependence on allowable independent claims, as well as by virtue of the features recited therein. Applicants therefore respectfully request withdrawal of the rejections and allowance of these claims.

As to claims 15, 20 and 23, Applicants respectfully traverse the Examiner's rejections. To establish a *prima facie* case of obviousness, the Examiner must establish that three criteria are met: (1) the prior art references must teach or suggest all the claim limitations; (2) some suggestion or motivation to combine the references must be found in the prior art; and (3) there must be a reasonable expectation of success. MPEP § 2143. Applicants respectfully submit that, as explained below, the Examiner has not established a *prima facie* case of obviousness.

Claim 15 was rejected by the Examiner as obvious over Li in view of Rigoni. Claim 15, as amended, recites an apparatus combination including a base capable of receiving a camera including a lens, an image processor capable of being coupled to the camera for processing an image of a target captured by the camera, and a confirmation projector coupled to the image processor, wherein "the projector emits an unfocused confirmation beam onto the plane of the target when the image processor signals the confirmation projector that the image processor has processed the image." The Examiner concedes that Li does not disclose a confirmation beam for confirming the processing of the image, but alleges that Rigoni discloses this feature. The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Li with Rigoni to arrive at the claimed invention.

Applicants respectfully disagree. The Examiner asserts that Rigoni can accomplish its functions without focusing its confirmation beam, but Rigoni clearly says otherwise. Rigoni discloses that its confirmation beam is and should be projected directly on and very closely around the symbol being read, where it is likely to capture the attention of the user (paragraph [0017]). Projecting a confirmation beam so closely around the symbol is impossible without focusing the beam, and consequently Rigoni specifies that the beam should be focused using lenses (*see, e.g.*, paragraphs [0043], [0059]). Rigoni therefore cannot disclose, teach or suggest a combination including a confirmation projector wherein the projector "emits an unfocused confirmation beam onto the plane of the target when the image processor signals the confirmation projector that the image processor has processed the image." Since the Examiner concedes that Li also does not disclose this element, the combination of Li and Rigoni cannot disclose every element and limitation of the claim and therefore cannot render the claim obvious. Applicants therefore respectfully request withdrawal of the rejection and allowance of the claim.

Claim 20 was rejected by the Examiner as obvious over Li in view of Rigoni. Claim 20 recites a process combination including capturing an image of a target on a plane using a camera,

processing the image captured by the camera using an image processor, and “projecting an unfocused confirmation beam onto the plane when the image processor signals to the confirmation projector that the image processor has processed the image.” By analogy to the discussion above in connection with claim 15, Applicants submit that Li and Rigoni cannot render the claim obvious because, even when combined, they do not disclose every element and limitation of the claim. Applicants therefore respectfully request withdrawal of the rejection and allowance of the claim.

Claim 23 was rejected by the Examiner as obvious over Li in view of Rigoni. Claim 23 recites an apparatus combination including a base capable of receiving an image processor and a camera including a lens and a projector coupled to the base and adapted to project a plurality of beams of light onto a plane positioned at a focus distance from the lens, wherein the projections of the beams of light on the plane are geometric shapes, and “wherein an intersection of the geometric shapes is at the center of the field of view of the lens independent of distance between the lens and the plane” when the lens is installed on the base. By analogy to the discussion above for claim 1, Li does not disclose, teach or suggest a combination including these elements and limitations. Rigoni also does not disclose these limitations. The combination of Li and Rigoni therefore cannot disclose every element and limitation in the claim. Applicants submit that Li and Rigoni therefore cannot render this claim obvious and respectfully request withdrawal of the rejection.

Regarding claims 16-19, 21-22 and 24-29, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claims 15, 20 and 23, as amended, are in condition for allowance. Applicants submit that claims 16-19, 21-22 and 24-29 are therefore allowable by virtue of their dependence on allowable independent claims, as well as by virtue of the features recited therein. Applicants therefore respectfully request withdrawal of the rejections and allowance of these claims.

Conclusion

Given the above amendments and accompanying remarks, all claims pending in the application are in condition for allowance. If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to allowance of the claims, the Examiner is

requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 292-8600.

Charge Deposit Account

Please charge our Deposit Account No. 02-2666 for any additional fee(s) that may be due in this matter, and please credit the same deposit account for any overpayment.

Respectfully submitted,

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Date: 10-11-05



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Enclosures: Postcard
Amendment transmittal, in duplicate
Declaration Under 37 C.F.R. § 1.132 with color figures
Copy of Declaration Under 37 C.F.R. § 1.132 with black-and-white figures